



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

Paper No.

FRISHAUF, HOLTZ, GOODMAN &
CHICK, PC
220 Fifth Avenue
16TH Floor
NEW YORK NY 10001-7708

COPY MAILED

APR 10 2007

OFFICE OF PETITIONS

| | | |
|-----------------------------|---|-------------------------|
| In re Application of | : | |
| Imanishi et al. | : | DECISION ON APPLICATION |
| Application No. 10/054,300 | : | FOR |
| Filed: January 22, 2002 | : | PATENT TERM ADJUSTMENT |
| Atty Docket No. 01834CIP/HG | : | |

This is a decision on the APPLICATION FOR PATENT TERM ADJUSTMENT INCLUDING REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT INDICATED IN NOTICE OF ALLOWANCE (37 CFR §1.705)" filed February 2, 2007. Applicants request that the initial determination of patent term adjustment under 35 U.S.C. 154(b) be corrected from four hundred seventy-three (473) days to one thousand one hundred nineteen (1119) days.

The application for patent term adjustment is **GRANTED to the extent indicated herein.**

The Office has updated the PAIR screen to reflect that the correct Patent Term Adjustment (PTA) determination at the time of the mailing of the Notice of Allowance is one thousand thirty-three (1033) days. A copy of the updated PAIR screen, showing the correct determination, is enclosed.

On January 4, 2007, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. The Notice stated that the patent term

adjustment (PTA) to date is 473 days. On February 2, 2007, applicants timely¹ submitted an application for patent term adjustment (with required fee). Applicants assert that the Office erred in entering a period of reduction of 646 days for applicant delay.

Applicants state that any patent granted on this application is not subject to a terminal disclaimer.

Applicants are correct that the reduction of 646 days is not warranted. A review of the application history confirms that applicants' complete response to the Notice to File Missing mailed March 25, 2002, was received in the Office on April 16, 2002. As such, the response was filed inside the three-month period under 37 CFR 1.704(b). Applicants did not fail to engage in reasonable efforts to conclude prosecution of the application by delaying in replying to the Notice to File Missing Parts of Application mailed March 25, 2002.

However, this review also reveals a basis for entry of a period of reduction for applicant delay. As stated in MPEP 2732:

37 CFR 1.704(c)(7) establishes submission of a reply having an omission (37 CFR 1.135(c)) as a circumstance that constitutes a failure of an applicant to engage in reasonable efforts to conclude processing or examination of an application.

Submitting a reply having an omission requires the Office to issue an action under 37 CFR 1.135(c) and await and process the applicant's reply to the action under 37 CFR 1.135(c) before the initial reply (as corrected) can be treated on its merits. In addition, 37 CFR 1.704(c)(7) provides that in such a case the period of adjustment set forth in 37 CFR 1.703 shall be reduced by the number of days, if any, beginning on the day after the date the reply having an omission was filed and ending on the date that the reply or other paper correcting the omission was filed. The reference to 37 CFR 1.135(c) is parenthetical because 37 CFR 1.704(c)(7) is not limited to Office actions under 37 CFR 1.135(c) but applies when the Office issues any action or notice indicating that a reply has an omission

¹ PALM records indicate that the Issue Fee payment was received on March 30, 2007.

which must be corrected: e.g., (1) a decision on a petition under 37 CFR 1.47 dismissing the petition as lacking an item necessary to grant the petition; or (2) a notice indicating that the computer readable format sequence listing filed in reply to a Notice to Comply with Requirements for Patent Applications Containing Nucleotide Sequence and/or Amino Acid Sequence Disclosures (PTO-1661) does not comply with 37 CFR 1.821 et seq.

On January 6, 2004, at the request of the Office, applicants submitted a duplicate CRF of sequence listing². By Notice mailed February 11, 2004, applicants were advised of omissions in this response. On April 1, 2004, applicants submitted a response correcting the omissions. Therein, applicants did not dispute the validity of the Office's assertion that there were omissions in their response. In addition, it is specifically noted that the Statement under 37 CFR 1.821 provided was signed March 18, 2004. Thus, it was not a duplicate from the earlier filing. This further supports a conclusion that there were omissions in applicants' response as originally filed April 16, 2002 (and resubmitted January 6, 2004). Thus, a period of reduction of 86 days for the period beginning on the day after the date the reply having an omission was filed, January 7, 2004, and ending on the date that the reply or other paper correcting the omission was filed, April 1, 2004 is properly entered.

In view thereof, the correct determination of patent term adjustment at the time of the mailing of the Notice of Allowance is one thousand thirty-three (1033) days.

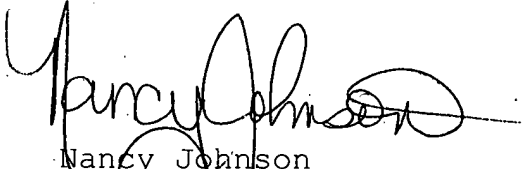
The Office acknowledges submission of the \$200.00 fee set forth in 37 CFR 1.18(e). No additional fees are required.

The Office of Patent Publication has been advised of this decision. The application is being forwarded to the Publications Division for issuance of a patent. The patent term adjustment indicated on the patent (as shown on the Issue Notification mailed about three weeks prior to patent issuance) will include any additional adjustment accrued both for Office delay in issuing the patent more than four months after payment

² As shown in the record of the application, applicants' original response filed April 16, 2002 was damaged in the mail (and thus, was not reviewed by the Office). Under the circumstances, it is appropriate to use the duplicate filed January 6, 2004 in ascertaining applicant delay pursuant to 1.704(c)(7).

of the issue fee and satisfaction of all outstanding requirements.

Telephone inquiries specific to this matter should be directed to the undersigned at (571) 272-3219.



Nancy Johnson
Senior Petitions Attorney
Office of Petitions

Enclosure: Copy of Revised PAIR Screen

| PTA Calculations for Application: 10/054300 | | | |
|---|------------|-------------------------|------|
| Application Filing Date: | 01/22/2002 | PTO Delay (PTO): | 1119 |
| Issue Date of Patent: | | Three Years: | 0 |
| Pre-Issue Petitions: | 0 | Applicant Delay (APPL): | 646 |
| Post-Issue Petitions: | 0 | Total PTA (days): | 1033 |
| PTO Delay Adjustment: | 560 | | |

| File Contents History | | | | | |
|-----------------------|------------|---|------|------|-------|
| Number | Date | Contents Description | PTO | APPL | START |
| 65 | 04/09/2007 | ADJUSTMENT OF PTA CALCULATION BY PTO | | 86 | |
| 64 | 04/09/2007 | ADJUSTMENT OF PTA CALCULATION BY PTO | 646 | | |
| 57 | 01/04/2007 | MAIL NOTICE OF ALLOWANCE | | | |
| 56 | 12/26/2006 | ISSUE REVISION COMPLETED | | | |
| 55 | 12/26/2006 | NOTICE OF ALLOWANCE DATA VERIFICATION COMPLETED | | | |
| 54 | 12/26/2006 | CASE DOCKETED TO EXAMINER IN GAU | | | |
| 53 | 12/26/2006 | NOTICE OF ALLOWABILITY | | | |
| 52 | 09/22/2006 | INFORMATION DISCLOSURE STATEMENT CONSIDERED | | | |
| 51 | 09/22/2006 | AFFIDAVIT(S) (RULE 131 OR 132) OR EXHIBIT(S) RECEIVED | | | |
| 50 | 09/22/2006 | REFERENCE CAPTURE ON IDS | | | |
| 49 | 09/22/2006 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | 0 | 47 |
| 48 | 09/29/2006 | DATE FORWARDED TO EXAMINER | | | |
| 47 | 09/22/2006 | RESPONSE AFTER NON-FINAL ACTION | | | |
| 46 | 06/27/2006 | MAIL NON-FINAL REJECTION | | | |
| 45 | 06/23/2006 | NON-FINAL REJECTION | | | |
| 44 | 04/01/2004 | INFORMATION DISCLOSURE STATEMENT CONSIDERED | | | |
| 43 | 03/09/2004 | INFORMATION DISCLOSURE STATEMENT CONSIDERED | | | |
| 42 | 04/19/2002 | INFORMATION DISCLOSURE STATEMENT CONSIDERED | | | |
| 41 | 05/01/2006 | DATE FORWARDED TO EXAMINER | | | |
| 40 | 04/26/2006 | RESPONSE TO ELECTION / RESTRICTION FILED | | | |
| 39 | 04/14/2006 | MAIL RESTRICTION REQUIREMENT | 1119 | | -1 |

| | | | | | |
|----|------------|--|--|-----|---|
| 38 | 04/13/2006 | REQUIREMENT FOR RESTRICTION / ELECTION | | | |
| 37 | 04/04/2006 | CASE DOCKETED TO EXAMINER IN GAU | | | |
| 36 | 11/23/2005 | IFW TSS PROCESSING BY TECH CENTER COMPLETE | | | |
| 35 | 04/22/2005 | CORRESPONDENCE ADDRESS CHANGE | | | |
| 34 | 10/20/2004 | MISCELLANEOUS INCOMING LETTER | | | |
| 33 | 04/01/2004 | REFERENCE CAPTURE ON IDS | | | |
| 32 | 04/01/2004 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 31 | 03/09/2004 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 30 | 07/17/2002 | PRELIMINARY AMENDMENT | | | |
| 29 | 04/24/2002 | PRELIMINARY AMENDMENT | | | |
| 28 | 04/19/2002 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 27 | 08/30/2004 | CASE DOCKETED TO EXAMINER IN GAU | | | |
| 26 | 04/19/2002 | REFERENCE CAPTURE ON IDS | | | |
| 24 | 08/26/2004 | CASE DOCKETED TO EXAMINER IN GAU | | | |
| 23 | 07/27/2004 | REFERENCE CAPTURE ON IDS | | | |
| 22 | 05/10/2002 | MISCELLANEOUS INCOMING LETTER | | | |
| 21 | 04/24/2002 | PRELIMINARY AMENDMENT | | | |
| 19 | 04/15/2004 | APPLICATION DISPATCHED FROM OIPE | | | |
| 18 | 04/16/2004 | APPLICATION IS NOW COMPLETE | | | |
| 17 | 04/01/2004 | ADDITIONAL APPLICATION FILING FEES | | 646 | 4 |
| 16 | 04/01/2004 | A SET OF SYMBOLS AND PROCEDURES, PROVIDED TO THE PTO ON A SET OF COMPUTER LISTINGS, THAT DESCRIBE IN | | | |
| 15 | 04/01/2004 | CRF DISK HAS BEEN RECEIVED BY PREEXAM / GROUP / PCT | | | |
| 14 | 01/22/2002 | CLAIM PRELIMINARY AMENDMENT | | | |
| 13 | 04/14/2004 | CRF IS GOOD TECHNICALLY / ENTERED INTO DATABASE | | | |
| 12 | 02/11/2004 | SEQUENCE ERRORS | | | |
| 9 | 04/16/2002 | ADDITIONAL APPLICATION FILING FEES | | | |
| 7 | 04/16/2002 | CRF DISK HAS BEEN RECEIVED BY PREEXAM / GROUP / PCT | | | |
| 6 | 02/09/2004 | CRF IS FLAWED TECHNICALLY / NOT ENTERED INTO DATABASE | | | |
| 5 | 04/11/2002 | A STATEMENT BY ONE OR MORE INVENTORS SATISFYING THE REQUIREMENT UNDER 35 USC | | | |

| | | | | | |
|---|------------|---|--|--|--|
| | | 115, OATH OF THE APPLIC | | | |
| 4 | 03/25/2002 | NOTICE MAILED--APPLICATION INCOMPLETE-- FILING DATE ASSIGNED | | | |
| 3 | 03/08/2002 | IFW SCAN & PACR AUTO SECURITY REVIEW | | | |
| 2 | 02/05/2002 | IFW SCAN & PACR AUTO SECURITY REVIEW | | | |
| 1 | 01/22/2002 | INITIAL EXAM TEAM NN | | | |

Search Another: Application#

Search

EXPLANATION OF PTA CALCULATION

EXPLANATION OF PTE CALCULATION

To go back use Back button on your browser toolbar.

Back to [PALM](#) | [ASSIGNMENT](#) | [OASIS](#) | [Home page](#)